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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,419	08/16/2000	Hartwig Schroder	48792	3392

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1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

SAIDHA, TEKCHAND

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622419

Applicant(s)

Schroder et al

Examiner

T. Saidha

Group Art Unit

1652

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/10/00 (IDS)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-14 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Lack of Unity of Invention

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6 & 12 (In-part), drawn to a process of producing biotin using a host organism transformed with at least gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 3 [bioS1].

Group II, claim(s) 1-6 & 12 (In-part), drawn to a process of producing biotin using a host organism transformed with at least gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 5 [bioS2].

Group III, claim(s) 1-6 & 12 (In-part), drawn to a process of producing biotin using a host organism transformed with at least gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 7 [bioS3].

Group IV, claim(s) 7-11 & 14 (In-part), drawn to a gene construct comprising gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 3 [bioS1].

Group V, claim(s) 7-11 & 14 (In-part), drawn to a gene construct comprising gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 5 [bioS2].

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Group VI, claim(s) 7-11 & 14 (In-part), drawn to a gene construct comprising gene sequences of SEQ ID NO : 1 [S-adenosylmethionine synthase gene] and SEQ ID NO : 7 [bioS3].

Group VII, claim(s) 13, use of gene sequence of SEQ ID NO : 7 [bioS3].

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I has a special technical feature of DNA sequences of SEQ ID NO : 1 & 3 used in transforming a host organism which Groups II-VII do not share; Group II has a special technical feature of DNA sequences of SEQ ID NO : 1 & 5 used in transforming a host organism which Groups I & III-VII do not share; Group III has a special technical feature of DNA sequences of SEQ ID NO : 1 & 7 used in transforming a host organism which Groups I-II & VI-VII do not share; Group IV has a special technical feature of a gene construct using DNA sequences of SEQ ID NO : 1 & 3 which Groups I-III & V-VII do not share; Group V has a special technical feature of a gene construct using DNA sequences of SEQ ID NO : 1 & 5 which Groups I-IV & VI-VII do not share; Group VI has a special technical feature of a gene construct using DNA sequences of SEQ ID NO : 1 & 7 which Groups I-V & VII do not share; Group VII has a special technical feature of using DNA sequences of SEQ ID NO : 3 which Groups I-VI do not share. Thus the various groups discussed show a lack of unity of invention.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. ***Sequence Rules***

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. See the enclosed notice to comply. Specifically, Rule 1.822(e) requires the use of three letter abbreviation for amino acids. See the enclosed notice to comply. Specifically, Rule 1.822(e) requires the use of three letter abbreviation for amino acids.

New Sequence Rules

Since the effective filing date after July 1, 1998, Applicants should follow the New Rule Format and submit a new Sequence Listing (both in electronic and paper format). Compliance according to the requirements of 37 CFR 1.821 through 1.825 is required.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (703) 305-6595. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group in the Technology Center is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Tekchand Saidha
Primary Examiner, Art Unit 1652
February 7, 2003